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Docket No.: 215742US0

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

**OBLON**  
**SPIVAK**  
**McCLELLAND**  
**MAIER**  
**&**  
**NEUSTADT**  
**P.C.**

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ATTORNEYS AT LAW

RE: Application Serial No.: 10/098,594

Applicants: Stefan UHRLANDT, et al.

Filing Date: March 18, 2002

For: INHOMOGENEOUS SILICAS AS CARRIER  
MATERIAL

Group Art Unit: 1754

Examiner: NGUYEN, NGOC YEN M.

SIR:

Attached hereto for filing are the following papers:

**Response to Restriction Requirement**

Our check in the amount of \_\_\_\_\_ is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

*Jane M. Terry*  
Jane M. Terry  
Registration No. 53,682

Customer Number

22850

(703) 413-3000 (phone)  
(703) 413-2220 (fax)

DOCKET NO: 215742US0



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

STEFAN UHRLANDT, ET AL. : EXAMINER: NGUYEN, NGOC YEN M.

SERIAL NO: 10/098,594 :

FILED: MARCH 18, 2002 : GROUP ART UNIT: 1754

FOR: INHOMOGENEOUS SILICAS AS  
CARRIER MATERIAL :

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement mailed March 26, 2004, Applicants elect,  
with traverse, Group I (claims 1-11) for further prosecution in the above-identified  
application.

The Office has required restriction of Claims 1-26 into the following groups:

- I. Claims 1-11, drawn to a silica.
- II. Claims 12-23, drawn to a process for preparing silicas.
- III. Claims 24-26, drawn to a method of supporting a substance.

Applicants elect, with traverse, Group I (claims 1-11) for further prosecution.

The Examiner has characterized the inventions of Groups I, II and III as distinct, as drawn to a product, a process of making and a process of use, respectively. The Examiner has asserted that the claimed product can be made by a materially different process and can be used by a materially different process, as noted in the present Office Action on pages 2-3. The Examiner has also asserted that the inventions of Groups II and III are unrelated, having different functions and different effects, as noted on page 3 of the present Office Action. Thus the Examiner required restriction among the above groups. Applicants respectfully traverse based on the following reasons.

Applicants submit that the Office has not made a proper restriction. Restriction is only proper if the claims of the restricted groups are either independent or distinct. There also must be a serious burden on the Examiner if restriction is required. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion in support of restriction (see MPEP § 803). Applicants respectfully submit that the Office has not demonstrated that it would be a serious burden to examine the entire application.

The Examiner provided only a general conclusion that the claimed product of Group I can be made by a materially different process, such as by controlling the process condition of a sol-gel process to produce bimodal silica particles. The Examiner did not provide any reasons or examples, in terms of, for example, specific reagents and experimental parameters, in support of this statement. Also, the Examiner provided only a general conclusion that the claimed product of Group I can be used in a materially different process, such as in fillers for

a metal matrix composite or as a desiccant, without providing any reasons or examples, in terms of, for example, specific experimental reagents and conditions in support of this statement. Additionally, the Examiner provided only a general conclusion that the claims of Groups II and III are unrelated as having different functions and effects, without providing any sort of reasons or examples in support of this statement. The burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and not on the Applicants to establish that they are not. Therefore, the Office has not supported its conclusion of restriction of the respective groups, and has not shown that it would be a serious burden to search and examine these groups together. Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants also submit that allowed cases, now U.S. Patents 6,702,887 and 6,613,309, having the same Assignee as the present application, contain claims directed to silicas and their respective process claims. Therefore, Applicants do not see why restriction would be required in the present case.

Applicants also submit that if the product claims are allowable, the process claims should be rejoined under MPEP § 821.04, if the process claims depend on, or include all the limitations of, the allowed product claim.

Accordingly, for at least the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary, in order to sustain the requirement for restriction in the present application. Applicants respectfully request the withdrawal of the Restriction Requirement.

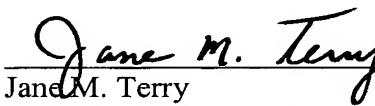
Applicants respectfully submit that the present application is now in condition for examination on the merits, and early notice of such action is earnestly requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 08/03)

  
Jane M. Terry  
Registration No. 53,682